

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Appl. No. : 10/528,544 Confirmation No.: 3962
Appellants : Winfried K. W. Holscher
Filed : September 26, 2005
TC/A.U. : 3679
Examiner : Ernesto Garcia

Docket No. : 05-196
Customer No. : 34704

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313

APPEAL BRIEF

Dear Sir:

This is an appeal to the Board of Patent Appeals and Interferences from the final rejection of claims 29 and 31 - 39, dated April 30, 2008, made by the Primary Examiner in Tech Center Art Unit 3679.

REAL PARTY IN INTEREST

The real party in interest is the Appellant, Winfried K. W. Holscher.

RELATED APPEALS AND INTERFERENCES

There are no other appeals or interferences known to Appellant or Appellant's legal representative which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

STATUS OF CLAIMS

Claims 1 - 28, 30, and 40 - 56 have been previously cancelled. Claims 29 and 31 - 39 are pending in the application and are on appeal.

A true copy of the claims on appeal are attached hereto as Appendix A.

STATUS OF AMENDMENTS

An amendment after final rejection was filed on October 30, 2008. In an advisory action mailed November 12, 2008, the Examiner indicated that the amendment after final rejection would be entered for the purposes of appeal.

SUMMARY OF CLAIMED SUBJECT MATTER

The present invention, as set forth in independent claim 29, relates to a connecting device for connecting a first workpiece having an interior space to a second workpiece (see page 1, lines 5 - 8, of the specification; also see Fig. 1). The connecting device comprises a clamping screw and a sleeve (see page 2, lines 29 - 31, of the specification; also see Fig. 1). The clamping screw has a shank which engages in a longitudinal groove of the first workpiece and which can be inserted into an opposing element in an interior space of the second workpiece (see page 2, line 29 to page 3, line 3 of the specification; also see Fig. 1). The shank of the clamping screw passes through the sleeve (see page 2, lines 29 - 30, of the specification; also see Fig. 1). The sleeve is provided with outer ribs (see page 3, lines 4 - 12 of the specification; also see Fig. 1) and is fixed in the longitudinal groove of the first workpiece such that a

threaded area of the clamping screw protrudes beyond a face of the first workpiece (see page 2, lines 29 - 33 of the specification; also see Fig. 3). The clamping screw is provided with a screw head (see page 2, line 33 to page 3, line 1 of the specification; also see Fig. 1). The threaded area of the clamping screw has a nut screw head which can be fitted thereon (see page 10, lines 23 - 28; also see Fig 1). The nut screw head is designed such that the nut screw head can be inserted into an undercut longitudinal groove of the second workpiece (see Fig. 1). The sleeve has at least three groups of the outer ribs which are parallel to a longitudinal axis of the sleeve (see page 3, lines 20 - 28 and page 10, lines 6 - 17 of the specification; also see Figs. 4 and 5). The outer ribs, in a fixing position, are assigned to radial grooves in a groove bottom and in facing surfaces of the longitudinal groove (see page 3, lines 20 - 28, of the specification; also see Figs. 4 and 5). One of the outer ribs is approximately triangular in cross section and merges with its rib faces into shaped channels of a sleeve outer face (see page 3, lines 4 - 20 of the specification; also see Figs. 1 and 2).

Claim 31 depends from claim 29 and is directed to the rib crests of a number of the outer ribs running parallel to one another (see page 3, lines 15 - 18, of the specification; also see Fig. 3).

Claim 32 depends from claim 29 and is directed to the rib crests of a number of the outer ribs defining a common annular contour (see page 3, lines 15 - 18, of the specification; also see Fig. 3).

Claim 33 depends from claim 29, and is directed to the outer ribs of the sleeves being capable of being inserted

in the radial grooves of the first workpiece (see page 3, lines 4 - 12 of the specification; also see Figs 1 - 3).

Claim 34 depends from claim 29, and is directed to one sleeve edge of the sleeve being fixed in the first workpiece being approximately flush with the face of the first workpiece (see page 3, lines 29 - 31 of the specification (see Figs. 1 - 3)).

Claim 35 is an independent claim and is directed to a connecting device for connecting a first workpiece having an interior space to a second workpiece (see page 1, lines 5 - 8, of the specification; also see Fig. 1). The connecting device comprises a clamping screw and a sleeve (see page 2, lines 29 - 31, of the specification; also see Fig. 1). The clamping screw has a shank which engages in a longitudinal groove of the first workpiece and which can be inserted into an opposing element in an interior space of the second workpiece (see page 2, line 29 to page 3, line 3 of the specification; also see Fig. 1). The shank of the clamping screw passes through the sleeve (see page 2, lines 29 - 30, of the specification; also see Fig. 1). The sleeve is provided with outer ribs (see page 3, lines 4 - 12 of the specification; also see Fig. 1) and is fixed in the longitudinal groove of the first workpiece such that a threaded area of the clamping screw protrudes beyond a face of the first workpiece (see page 2, lines 29 - 33 of the specification; also see Fig. 3). The clamping screw is provided with a screw head (see page 2, line 33 to page 3, line 1 of the specification; also see Fig. 1). The threaded area of the clamping screw has a nut screw head which can be fitted thereon (see page 10, lines 23 - 28; also see Fig 1). The nut screw head is designed such that said nut screw head can be inserted into an undercut

longitudinal groove of the second workpiece (see Fig. 1). The sleeve has at least three groups of the outer ribs which are parallel to a longitudinal axis of the sleeve (see page 3, lines 20 - 28 and page 10, lines 6 - 17 of the specification; also see Figs. 4 and 5), which said outer ribs, in a fixing position, are assigned to radial grooves in a groove bottom and in facing surfaces of the longitudinal groove (see page 3, lines 20 - 28, of the specification; also see Figs. 4 and 5). One sleeve edge of the sleeve is fixed in the first workpiece being approximately flush with the face of the first workpiece (see page 3, lines 29 - 31 of the specification (see Figs. 1 - 3) and wherein a ring, which is made of elastic material and surrounds the threaded area of the clamping screw, is arranged between the one sleeve edge and the screw head (see page 10, lines 18 - 30 of the specification; also see Fig. 1).

Claim 36 depends from claim 29 and is directed to the screw head which can be screwed onto the clamping screw being designed in a plate-shaped manner (see page 4, lines 10 - 12 of the specification; also see Fig. 7).

Claim 37 depends from claim 36 and is directed to a length of the screw head being shorter than a width of a groove space of the undercut longitudinal groove which receives the screw head (see page 4, lines 12 - 14 of the specification; also see Fig. 1).

Claim 38 depends from claim 35 and is directed to the outer ribs delimiting the longitudinal groove being designed in a hook-shaped manner (see page 9, lines 6 - 7, of the specification; also see Fig. 1) and faces of hook ends which are directed toward the groove bottom being

designed as an abutment for the screw head (see page 4, lines 16 - 21 of the specification; see Fig. 1).

Claim 39 depends from claim 38 and is directed to the hook ends having a height which corresponds approximately to a height of the ring made of elastic material which is mounted between them (see page 4, lines 21 - 23 of the specification; also see Fig. 1).

GROUND(S) OF REJECTION TO BE REVIEWED ON APPEAL

The sole ground of rejection to be reviewed on appeal is the rejection of claims 29 and 31 - 39 under 35 U.S.C. 112, second paragraph.

ARGUMENT

(1) Independent Claims 29 and 35 Meet The Requirements of 35 U.S.C. 112, Second Paragraph And Are Definite

The sole issue before the Board is whether claims 29 and 35 each meet the notice function required by 35 U.S.C. 112, second paragraph.

The second paragraph of 35 U.S.C. 112 is directed to the requirements for the claims.

"The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention."

The two requirements of this section of the patent statute are: (A) the claims must set forth the subject matter that applicants regard as their invention; and (B) the claims must particularly point out and distinctly

define the metes and bounds of the subject matter that will be protected by the patent grant.

With regard to requirement (A), Appellant has never stated that the invention is anything other than what is being claimed in claim 29 and/or claim 35. The rejection made by the Examiner lacks any evidence which would show that the claimed subject matter is not what Appellant regards as his invention. In the absence of such evidence, it must be presumed that the invention set forth in the claims is that which Appellant regards as his invention. See *In re Moore*, 439 F.2d 1232 (CCPA 1971); also see Manual of Patent Examining Procedure (M.P.E.P.) § 2172.

As for requirement (B), claims 29 and 35 each particularly points and distinctly claims the invention in a manner which is clear so the public is informed of the boundaries of what constitutes infringement of the patent. For example, it is clear from both claims 29 and 35 that the invention is directed to a connecting device for connecting a first workpiece having an interior space to a second workpiece. It is further clear that the connecting device must comprise a clamping screw and a sleeve. It is also clear that the clamping screw must have a shank which engages in a longitudinal groove of the first workpiece and which can be inserted into an opposing element in an interior space of the second workpiece, which shank passes through the sleeve. Each claim is further clear that the sleeve must be provided with outer ribs and must be fixed in the longitudinal groove of the first workpiece such that a threaded area of the clamping screw protrudes beyond a face of the first workpiece. It is further clear that the clamping screw must be provided with a screw head and that the threaded area of the clamping screw has a nut screw

head which can be fitted thereon. It is also clear that the nut screw head must be designed such that the nut screw head can be inserted into an undercut longitudinal groove of the second workpiece. Still further, it is clear that the sleeve must have at least three groups of outer ribs which are parallel to a longitudinal axis of the sleeve. Further with respect to both claims 29 and 35, it is also clear that the outer ribs, in a fixing position, must be assigned to radial grooves in a groove bottom and in facing surfaces of the longitudinal groove. It is also clear from claim 29 that one of the outer ribs must be approximately triangular in cross section and merge with its rib faces into shaped channels of a sleeve outer face. It is clear from claim 35 that one sleeve edge of the sleeve must be fixed in the first workpiece and approximately flush with the face of the first workpiece. It is further clear from claim 35, that the connecting device must include a ring, which is made of elastic material and surrounds the threaded area of the clamping screw, which ring is arranged between the one sleeve edge and the screw head.

A comprehensive review of the claims 29 and 35 shows that the public would, and should, have no problem comprehending what constitutes infringement of either claim 29 or claim 35. The Examiner in making the rejection under the second paragraph of 35 U.S.C. 112 does not point out any reason why the public would have a problem in comprehending what constitutes infringement of either claim 29 or claim 35.

A fundamental principle contained in 35 U.S.C. 112, second paragraph, is that applicants are their own lexicographers. They can define in the claims what they regard as their invention essentially in whatever terms

they choose so long as the terms are not used in ways that are contrary to accepted meanings in the art. See M.P.E.P. 2173.01. Applicant may use functional language, alternative expressions, negative limitations, or any style of expression or format which makes clear the boundaries of the subject matter for which protection is sought. *Id.* As noted by the court in *In re Swinehart*, 439 F.2d 210 (CCPA 1971), a claim may not be rejected solely because of the type of language used to define the subject matter for which patent protection is sought.

The examiner's focus during examination of claims for compliance with the requirement for definiteness is whether the claim under review meets the threshold requirements of clarity and precision, not whether more suitable language or modes of expression are available. In this case, the Examiner's rejection is simply a dissatisfaction with the manner in which Appellant has claimed his invention. Appellant submits that there is nothing improper in claiming the components of an invention in the environment in which they are used. The combination-subcombination distinction raised by the Examiner is not a basis for rejecting the claim under 35 U.S.C. 112, first paragraph. The sole basis for rejecting the claim is presenting evidence which would lead one to conclude that the public is not informed as to the boundaries of what constitutes infringement of the patent. The Examiner has not provided any such evidence and thus the rejection fails.¹

Definiteness of claim language must be analyzed, not in a vacuum, but in light of: (A) the content of the

¹ On this point, it should be noted that the Examiner, having found allowable subject matter, has not provided any suggested claim language which would in his opinion improve clarity or precision of the language used. See M.P.E.P. 2173.02.

particular application disclosure; (B) the teachings of the prior art; and (C) the claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made. See M.P.E.P. 2173.02. In the advisory action mailed November 12, 2008, the Examiner makes the following statement:

“For example, lines 1 - 3 still imply that only the subcombination is being claimed (combination merely referred to as intended use) while the body of the claim still positively includes the elements of the combination.” (See paragraph 11 continuation on page 2 of the advisory action.)

It is submitted by Appellant that this statement is not the analysis which must be done to question the definiteness of the claim language. The Examiner has not explained why the metes and bounds of the claims would not be understood after reading the application disclosure. There is also no statement as to how one possessing the ordinary level of skill in the pertinent art at the time the invention was made would interpret the claim and why they would interpret it in the manner suggested by the Examiner. In the instant case, one would readily understand the connecting device to be used to join to workpieces together and the manner in which the components of the connecting device interact with the workpieces. The Examiner has clearly failed to meet his burden of considering the claims as a whole to determine whether the claim apprises one of ordinary skill in the art of its scope and thus serves its notice function. See *Solomon v. Kimberly-Clark Corp.*, 216 F.3d 1372, 1379 (Fed. Cir. 2000). Also see *In re Larsen*, No. 01-1092 (Fed. Cir. May 9, 2001) (*unpublished*) (The preamble of the *Larsen* claim recited only a hanger and a loop but the body of the claim positively recited a linear member.

The court observed that the totality of all the limitations of the claim and their interaction with each other must be considered to ascertain the inventor's contribution to the art. Upon review of the claim in its entirety, the court concluded that the claim at issue apprises on of ordinary skill in the art of its scope and, therefore, serves the notice function required by 35 U.S.C. 112, paragraph 2.).²

Appellants submit that, when one considers the claim as a whole in light of the disclosure in the instant application, the metes and bounds of independent claims 29 and 35 are clear. Each claim is clear that the connecting device for joining the first workpiece to the second workpiece comprises a clamping screw and a sleeve. As for the first and second workpieces being recited in the body of the claim after the word "comprising", as previously discussed, such a recitation is needed to place the clamping screw and the sleeve in the overall environment in which they are used. There is no prohibition against such claim language in 35 U.S.C. 112, second paragraph, and the presence of the first and second workpieces in the body of the claim does not cause the claim to lose its notice serving function. If anything the presence of the first and second workpieces in the body of the claim enhances the notice serving function of both claims 29 and 35. As for the Examiner stating on page 5 of the final rejection that the workpiece is part of the connecting device, the Examiner's position is wrong. One of ordinary skill in the art would understand that the connecting device is used to connect two workpieces and that neither workpiece is part

² The *Larsen* case is cited in M.P.E.P. 2173.02.

of the connecting device. This is the plain and simple language of the claim.

If the presence of the first and second workpieces in the body of the claim would cause one to interpret claims 29 and 35 as combination claims, so be it. The purported combination and subcombination distinction has nothing at all to do with the issue of notice since it is all the limitations of the claim, including the preamble, which determine the scope of the claim.

With regard to the other issues raised on page 5 regarding indefiniteness, i.e. "is provided with a screw head" and "a profile side face", these issues are now moot since the language has been deleted from the claims on appeal.

For these reasons, the rejection of claims 29 and 35 on indefiniteness grounds should be reversed.

(ii) Claims 31 - 34 and 36 - 39

Each of claims 31 - 34 and 36 - 39 depends, either directly or indirectly, from one of claims 29 and 35. Thus, the definiteness of these dependent claims hinges on the definiteness of their parent claims since they include the subject matter of their parent claims. The Examiner has not pointed out any separate basis for finding any of claims 31 - 34 and 36 - 39 indefinite.

CONCLUSION

For the foregoing reasons, the Board is hereby requested to reverse the rejection of record and remand the instant application back to the Primary Examiner for allowance.

CLAIMS APPENDIX A

Attached hereto is a Claims Appendix A containing all claims in the application and which form the basis for this appeal.

EVIDENCE APPENDIX B

None.

SPECIAL PROCEEDINGS APPENDIX C

None.

APPEAL BRIEF FEE

The Director is hereby authorized to charge the appeal brief fee of \$540.00 to Deposit Account No. 02-0184. Should the Director determine that an additional fee is due, he is hereby authorized to charge said additional fee to said Deposit Account.

Respectfully submitted,
Winfried K. W. Holscher

By /Barry L. Kelmachter #29999/
Barry L. Kelmachter
BACHMAN & LaPOINTE, P.C.
Reg. No. 29,999
Attorney for Appellants

Telephone: (203)777-6628 ext. 112
Telefax: (203)865-0297
Email: docket@bachlap.com

Date: December 30, 2008

CLAIMS ON APPEAL - APPENDIX A

29. A connecting device for connecting a first workpiece having an interior space to a second workpiece, said connecting device comprising:

a clamping screw and a sleeve;

the clamping screw having a shank which engages in a longitudinal groove of the first workpiece and which can be inserted into an opposing element in an interior space of the second workpiece;

the shank of the clamping screw passing through the sleeve;

said sleeve being provided with outer ribs and being fixed in the longitudinal groove of the first workpiece such that a threaded area of the clamping screw protrudes beyond a face of the first workpiece;

said clamping screw being provided with a screw head;

the threaded area of the clamping screw having a nut screw head which can be fitted thereon;

said nut screw head being designed such that said nut screw head can be inserted into an undercut longitudinal groove of the second workpiece;

the sleeve having at least three groups of said outer ribs which are parallel to a longitudinal axis of the sleeve;

said outer ribs, in a fixing position, being assigned to radial grooves in a groove bottom and in facing surfaces of the longitudinal groove; and

wherein one of said outer ribs is approximately triangular in cross section and merges with its rib faces into shaped channels of a sleeve outer face.

31. The connecting device as claimed in claim 29, wherein rib crests of a number of said outer ribs run parallel to one another.

32. The connecting device as claimed in claim 29, wherein rib crests of a number of said outer ribs define a common annular contour.

33. The connecting device as claimed in claim 29, wherein the outer ribs of the sleeve can be inserted in said radial grooves of the first workpiece.

34. The connecting device as claimed in claim 29, wherein one sleeve edge of the sleeve fixed in the first workpiece is approximately flush with the face of the first workpiece.

35. A connecting device for connecting a first workpiece having an interior space to a second workpiece, said connecting device comprising:

a clamping screw and a sleeve;

the clamping screw having a shank which engages in a longitudinal groove of the first workpiece and which can be inserted into an opposing element in an interior space of the second workpiece;

the shank of the clamping screw passing through the sleeve;

said sleeve being provided with outer ribs and being fixed in the longitudinal groove of the first workpiece such that a threaded area of the clamping screw protrudes beyond a face of the first workpiece;

said clamping screw being provided with a screw head;

the threaded area of the clamping screw having a nut screw head which can be fitted thereon;

said nut screw head being designed such that said nut screw head can be inserted into an undercut longitudinal groove of the second workpiece;

the sleeve having at least three groups of said outer ribs which are parallel to a longitudinal axis of the sleeve, which said outer ribs, in a fixing position, are assigned to radial grooves in a groove bottom and in facing surfaces of the longitudinal groove;

one sleeve edge of the sleeve fixed in the first workpiece being approximately flush with the face of the first workpiece; and

wherein a ring, which is made of elastic material and surrounds the threaded area of the clamping screw, is arranged between the one sleeve edge and the screw head.

36. The connecting device as claimed in claim 29, wherein the screw head which can be screwed onto the clamping screw is designed in a plate-shaped manner.

37. The connecting device as claimed in claim 36, wherein a length of the screw head is shorter than a width of a groove space of the undercut longitudinal groove which receives the screw head.

38. The connecting device as claimed in claim 35, wherein the outer ribs delimiting the longitudinal groove are designed in a hook-shaped manner and faces of hook ends which are directed toward the groove bottom are designed as an abutment for the screw head.

39. The connecting device as claimed in claim 38, wherein the hook ends have a height which corresponds approximately to a height of the ring made of elastic material which is mounted between them.

EVIDENCE - APPENDIX B

NOT APPLICABLE

RELATED PROCEEDINGS - APPENDIX C

NOT APPLICABLE